

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

*The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and (2)
is not binding precedent of the Board.*

Paper No. 105

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GEORGE H. CAVANAGH, III,

Junior Party,¹

v.

GARFIELD W. McMAHON and DENNIS F. JONES,

Senior Party.²

Patent Interference No. 102,668

JUDGMENT

¹ Application 07/451,913, filed December 18, 1989.
Assignee: Hazeltine Corporation, a corporation of Delaware.

² Patent 4,922,470, issued May 1, 1990 based on Application 07/271,466, filed November 15, 1988. Assignee: Her Majesty the Queen in Right of Canada, as Represented by the Minister of Defence of Her Majesty's Canadian Government, Canada.

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URYNOWICZ, PATE, and MARTIN, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

The subject matter of this interference is an electro-acoustic transducer for generating acoustic waves in water. Count 1, the sole count, reads as follows:

An electro-acoustic transducer comprising:

first means for producing acoustic signals in response to a stimulus, said first means comprising a plurality of staves, each stave having two ends, with predetermined shapes, forming an enclosure;

second means for producing said stimulus,
coupled to said first means; and

a spaced apart pair of polygonal shaped end plates, each of said staves secured from one end plate to the other said end plate.

The claims of the parties that stand designated as corresponding to the count are:

Cavanagh application claims 1-28; and

McMahon et al. (McMahon) patent claims 1-20.

This is the second "final" hearing in this interference. The first final hearing, held on December 2, 1993,

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stemmed from McMahon's § 1.633(a) motion for judgment against Cavanagh's claims on the ground of unpatentability over disclosures made by Dennis Jones, one of the McMahon inventors, at a November 16-20, 1987, meeting of the Acoustical Society of America in Miami, Florida (hereinafter, "the Miami meeting").

After initially deciding to defer consideration of the motion until a final hearing on priority,³ the Administrative Patent Judge (APJ) granted the motion based on a "first" Jones declaration⁴ and ordered Cavanagh to show cause why judgment should not be entered against his claims under 35 U.S.C. §§ 102 and/or 103 based on Jones's disclosures at the Miami meeting. Cavanagh's request for a final hearing was granted, as was his request for a testimony period, during which he deposed Jones regarding his first affidavit. Both parties

³ Paper No. 15; adhered to on reconsideration in paper No. 22.

⁴ Executed November 26, 1991, included in McMahon's Record (MR) at MR 6-9. The year is incorrectly given in the index of witnesses (MR 2) as 1996. Because the interference rules use the term "affidavit" to refer to an affidavits or a declaration (see §1.601(b)), all declarations are referred to hereinafter as affidavits. Also, the terms "affidavit" and "deposition testimony" as used herein include any exhibits referenced therein.

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were represented at the hearing on December 2, 1993. In a decision entered June 2, 1994,⁵ a three-member panel of the Board of Patent Appeals and Interferences (Board) held that because the first Jones affidavit and the Jones deposition testimony lacked corroboration by a noninventor, they were insufficient to make out a prima facie case of unpatentability, citing Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 860, 20 USPQ2d 1252, 1260 (Fed. Cir. 1991), cert. denied, 504 U.S. 980 (1992) ("Courts have commented on the inherent discredit that may be placed upon an inventor's testimony, especially when relating to the teachings of the prior art or to the inventor's recollection of the act of invention.").⁶ Accordingly, the panel reversed the APJ's decision granting the motion and remanded the interference to the APJ. McMahon filed two successive requests for reconsideration including new affidavits by Charles Schmid and Jan Lindberg, which were refused consideration on the ground that McMahon failed to show

⁵ Paper No. 58.

⁶ Decision at 14.

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sufficient cause (hereinafter, good cause⁷) for their belatedness.⁸ After the APJ had issued a schedule⁹ setting dates for the parties to present priority testimony and to file records and briefs but before the start of Cavanagh's testimony-in-chief period, McMahon again raised the foregoing patentability issue by filing a belated § 1.633(a) motion¹⁰ accompanied by the first Jones affidavit, the Lindberg affidavit and a new affidavit by McMahon's counsel, Mark Bicks, purporting to explain the delay in filing the Lindberg affidavit. The belated motion was denied by the APJ¹¹ because the Bicks affidavit failed to show good cause for the delay in filing the Lindberg affidavit.

⁷ Effective April 21, 1995, the term "sufficient cause" in § 1.645(b) was changed to "good cause" to be consistent with the terminology used in other interference rules. Patent Appeal and Interference Practice -- Final Rule, 60 Fed. Reg. 14,488, 14,513 (March 17, 1995); 1173 Off. Gaz. Pat. & Trademark Office 36, 57 (April 11, 1995) (hereinafter 1995 Final Rule Notice).

⁸ Paper Nos. 66 and 72.

⁹ Paper No. 73.

¹⁰ Paper No. 77.

¹¹ Paper No. 80; adhered to on reconsideration in paper No. 85.

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In connection with this final hearing, both parties filed records and briefs¹² addressing priority and the foregoing patentability issue. McMahon has moved to strike parts of Cavanagh's reply brief and Cavanagh has moved to suppress much of the evidence on which McMahon relies to prove what was disclosed at the Miami meeting. Appearance at oral hearing was waived by both parties.¹³

McMahon's motion to strike parts of Cavanagh's reply brief

This motion seeks to strike a copy of a previously filed amendment that accompanied Cavanagh's reply brief and a number of factual allegations in the reply brief. The amendment in question was initially filed in Cavanagh's involved application¹⁴ along with a number of § 1.608(b) affidavits in order to provoke this interference. Cavanagh supplied a copy of this amendment with his reply brief in response to McMahon's argument (Br. at 19) that Cavanagh's affidavit is incomplete to the extent he claims he "invented

¹² Cavanagh's opening and reply briefs are identified as "Open. Br." and "Reply Br."). McMahon's brief is identified as "Br."

¹³ Paper No. 101.

¹⁴ Application paper No. 6, received September 28, 1990.

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the invention set forth in each and every count alleged in the Amendment attached hereto," because a copy of the amendment was not included among Cavanagh's exhibits for consideration at this final hearing.

The factual allegations McMahon seeks to strike were made in response to McMahon's argument (Br. at 17-19) that Cavanagh's evidence fails to establish that the acts relied on to prove priority occurred in the United States, as required by 35 U.S.C. § 104.¹⁵ Those allegations are as follows:

(1) "The location for these acts [of conception and reduction to practice] was the Hazeltine facilities located in the Commonwealth of Massachusetts." (Reply Br. at 4.)

(2) "Party Cavanagh, III's date of conception and reduction to practice occurred in the Commonwealth of Massachusetts on the declared dates." (Id. at 5.)

(3) "Hazeltine Corporation is a U.S. corporation with headquarters located at 450 E. Pulaski Road, Greenlawn, N.Y. 11740. Hazeltine's EASL facilities, where the date of invention was established, are located in Braintree and Quincy, MA. EASL had no facilities outside of Massachusetts at the time of the date of invention." (Ibid.)

¹⁵ Subject to a number of exceptions that both parties agree do not apply to either party in this interference, § 104 specifies that "an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country."

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(4) "Inventor Cavanagh, III, was an employee of Hazeltine located at the Massachusetts facilities at the time of the invention." (Ibid.)

(5) "All of the witnesses were also Hazeltine employees at the Massachusetts facilities." (Ibid.)

(6) "Inventor Cavanagh, III's invention was conceived while he was employed by Hazeltine at the EASL facilities. Laboratory Notebook of Inventor Cavanagh, III was signed and dated at the Hazeltine facilities in Braintree, Massachusetts and signed and dated by other Hazeltine employees and routinely kept." (Ibid.)

Cavanagh opposes the motion to strike on procedural and substantive grounds, the procedural ground being that it fails to include a § 1.637(b) certificate of prior consultation with opposing counsel, as is required of all § 1.635 motions except motions to suppress evidence (see § 1.656(h)). McMahon responds (1) that a § 1.637(b) certificate was not required, as the motion is in the nature of a motion to suppress, which does not require a certificate, and (2) that even assuming a § 1.637(b) certificate was required, its omission was harmless error because the motion clearly could not have been resolved by agreement. We do not agree with either argument and accordingly are dismissing the motion for failing to include the certificate.

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Nevertheless, while the copy of the amendment is not being suppressed, the portion on which Cavanagh's § 1.608(b) affidavit relies, i.e., the statement that he invented the subject matter set forth in the three counts proposed therein, is entitled to weight only if corroborated by other evidence. As for the factual allegations in the reply brief, to the extent they lack support in the evidence of record they are entitled to no weight, because they constitute mere attorney argument, which cannot take the place of evidence. Meitzner v. Mindick, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA), cert. denied, 434 U.S. 854, 195 USPQ 465 (1977).

Cavanagh's priority case

Inasmuch as Cavanagh's involved application was filed prior to issuance of McMahon's involved patent, Cavanagh's burden of proof on the issue of priority is by a preponderance of the evidence. 37 CFR § 1.657(b). In order to satisfy this standard, the evidence must demonstrate that it is more likely than not that the alleged acts actually occurred. See Bosies v. Benedict, 27 F.3d 539, 541-42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1994) (the preponderance of the evidence standard requires the finder of fact to believe

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that the existence of a fact is more probable than its nonexistence).

Cavanagh's priority evidence consists of the previously filed § 1.608(b) affidavits by Cavanagh, Packard, Pelrin, DiCaprio, Moore, and Frazer, whom McMahon elected not to cross-examine. Cavanagh argues that he conceived the invention on July 27, 1988, reduced it to practice on August 26, 1988, and was diligent during the one-month period between these dates. We will begin by considering whether evidence proves an actual reduction to practice, which is an essential element of Cavanagh's case for priority.¹⁶

To establish priority based upon an alleged actual reduction to practice, Cavanagh is required to prove, inter alia, that he constructed a transducer meeting every limitation of the count and that it worked for its intended purpose. Newkirk v. Lulejian, 825 F.2d 1581, 1582, 3 USPQ2d 1793, 1794 (Fed. Cir. 1987). Cavanagh concedes that testing

¹⁶ Cavanagh does not alternatively argue that he is entitled to priority based on conception plus diligence from just prior to McMahon's entry into the filed up to Cavanagh's filing date.

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is required to establish the invention's operability for its intended purpose.¹⁷

Packard, the only witness who claims to have seen a test of a transducer that allegedly satisfies the count, testified as follows (CR¹⁸ 4-5):

2. To the best of my recollection, during the month of August, 1988, I witnessed the operation of [sic, a] transducer design prototype invented by Mr. George H. Cavanagh III as described in Exhibits "A", "B", "D" in the §1.608(b) Declaration filed by Mr. Cavanagh, dated 9/19/90 [CR 2-3].

3. This device was tested in my presence at the Hazeltine facility known as "the quarry". The test results obtained during August, 1988 are shown in Exhibit "C" of the above-referenced declaration. Further, I signed Mr. Cavanagh's Engineering note book, pages 12548-3 & 12548-31, marked Exhibits "E" and "F" respectively, copies attached hereto, confirming that I had witnessed successful operation of the above-referenced invention during August, 1988.

¹⁷ Cavanagh does not contend that the operability of the invention is ascertainable from mere inspection of an embodiment of the invention, as is necessary to avoid the need for testing. Compare In re Asahi/America, Inc., 68 F.3d 442, 445, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) ("[t]here are some devices so simple that a mere construction of them is all that is necessary to constitute a reduction to practice") (quoting Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931)).

¹⁸ Cavanagh Record.

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Exhibit A, a sketch of an assembled transducer, shows two "DRIVE ENDS" which are separated by ceramic stacks and held together by a tie rod, with two outer bars shown connected between the drive ends. Exhibit B is a sketch of an "END MASS" that appears to be one of the "DRIVE ENDS" shown in Exhibit A. Exhibit C, the graph of the test results, has an x axis which is a logarithmic frequency scale between 100 and 10,000 Hz and a y axis which appears to represent "db" values between 0 and -40. Exhibit D consists of photocopies of two photographs of the device Packard says he saw tested in August 1988. Although Packard's signature confirming the success of the tests he observed appears on Exhibits E and F, which show structural details not apparent in Exhibits A, B, and D, the clear meaning of Packard's above-quoted testimony is that the device he saw tested is the device depicted in Exhibits A, B, and D (as opposed to Exhibits E and F). This conclusion is also consistent with the testimony of Pelrin, who explained that in August 1988 he saw a device that was constructed as shown in Exhibits A, B, and D (CR 6-7):

2. To the best of my recollection, during August, 1988, George Cavanagh requested my advice

concerning the construction of a test prototype for a new transducer design. Exhibits "A", "B", and "D" in the in the §1.608(b) Declaration filed by George H. Cavanagh III, dated 9/19/90 show the prototype transducer design that Mr. Cavanagh had brought to my attention during August of 1988.

3[.] I recall that the prototype as shown in the photographs marked Exhibit "D" had two TR317 stacks of transducers fastened together with gasket eliminator. This is shown in [the] left-hand photograph in Exhibit "D" as a "red line" towards the bottom of the transducer stack. The original transducer stack shown in the photograph is still at the Hazeltine facility in Braintree.

4. I recall that Mr. Cavanagh had asked for my advice concerning boot attachment for his device. I had recommended the use of Chemlok 304. The right photograph in Exhibit "D" is a picture of Mr. Cavanagh's prototype with the rubber boot in place using Chemlok 304 as I suggested.

The testimony of Packard and Pelrin convinces us that the device that Packard saw tested in August 1988 is the device depicted in Cavanagh Exhibits A, B, and D and that the results of those tests appear in Exhibit C. McMahon faults the testimony of these witnesses as not corroborated by another witness (Br. at 20). This criticism is unfounded because the testimony of a witness who is not an inventor need not be corroborated. Holmwood v. Sugavanam, 948 F.2d 1236, 1239, 20 USPQ2d 1712, 1714 (Fed. Cir. 1991)(citing Borrer v. Herz, 666 F.2d 569, 573, 213 USPQ 19, 22 (CCPA 1981)).

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As additional evidence of the alleged actual reduction to practice, Cavanagh relies on the testimony of Moore, who at the time of the alleged reduction to practice was Director of Engineering at the EASL Division of Hazeltine (CR 11, para. 3). Moore testified that on or about September 16, 1988, he received from Cavanagh a copy of the memorandum identified as Exhibit G, which "describ[es] a [sic, an] edge driven bar transducer and the test results obtained from that device" (CR 10, para. 1). Cavanagh does not contend, and no witness testified, that the device and tests described in this memorandum are those that were observed by Packard in August 1988. Instead, as explained infra, Cavanagh relies on Moore's opinion about the success of the tests described in this memorandum as evidence of the success of the tests observed by Packard (Open. Br. at 10-11; Reply Br. at 6).

McMahon attacks Cavanagh's evidence of an actual reduction to practice on a number of grounds, the first being that it fails to establish by a preponderance of the evidence that the acts relied on to prove prior invention occurred in the United States, as required by 35 U.S.C. § 104. This issue

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was not addressed in Cavanagh's opening brief, which argued that McMahon's evidence fails to satisfy this requirement but fails to explain why Cavanagh's evidence does. Cavanagh argues (Reply Br. at 3-4) that he was not required to address this point in his opening brief because (1) the examiner, by forwarding the Cavanagh application and the McMahon patent to the Board for declaration of the interference, necessarily determined that the § 1.608(b) affidavits prima facie demonstrate prior invention in this country and (2) the APJ, by declaring the interference without concurrently issuing a § 1.617(a) show cause order challenging the sufficiency of the § 1.608(b) affidavits, likewise necessarily determined that they establish a prima facie case of prior invention in this country. However, neither of these interlocutory decisions by the examiner and the APJ is binding on this panel.

Furthermore, whereas they concern compliance with the "prima facie" standard of § 1.608(b), the issue before the Board at this hearing is whether Cavanagh priority evidence satisfies the higher, preponderance of the evidence standard under § 1.657(a). Compare Kahl v. Scoville, 609 F.2d 991, 995, 203 USPQ 652, 655 (CCPA 1979) (with respect to affidavits

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under 37 CFR § 1.204(c), the predecessor to § 1.608(b), "the burden on [appellants] is not to prove beyond a reasonable doubt, or even by a preponderance of the evidence, but merely to establish a prima facie case") (quoting Schwab v. Pittman, 451 F.2d 637, 640, 172 USPQ 69, 71 (CCPA 1971)).

Cavanagh also complains that McMahon never raised the "in this country" issue before, never availed himself of the opportunity to pursue this question during cross-examination of Cavanagh's witnesses, and has not offered a scintilla of evidence that the reduction to practice occurred outside the United States. These arguments, too, are unconvincing. While McMahon was obliged by § 1.672(c) to give notice during Cavanagh's testimony-in-chief period of any admissibility problems McMahon intended to raise at final hearing, he was not required, prior to filing his brief, to attack Cavanagh's evidence for failing to satisfy the preponderance of the evidence standard. Nor was McMahon required to file rebuttal evidence on this question. See Linkow v. Linkow, 517 F.2d 1370, 1374, 186 USPQ 223, 226 (CCPA 1975) (no adverse inference can be drawn from failure of senior party to present any testimony, because senior party

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has the right to stand on his position that the junior party failed to present a prima facie case).

For the foregoing reasons, we agree with McMahon that Cavanagh has an affirmative duty to prove by a preponderance of the evidence that the acts relied on to prove a date of invention occurred in this country, i.e., that it is more likely than not that the acts relied on to prove a date of invention occurred in this country. Bosies, 27 F.3d at 541-42, 30 USPQ2d at 1864.

Turning now to the merits, while Packard testified that the testing he observed took place at the "Hazeltine facility known as 'the quarry'" (CR 4, para. 3), he did not identify its location. Likewise, Pelrin, who testified that "[t]he original transducer stack shown in the photograph [Exhibit D] is still at the Hazeltine facility in Braintree," failed to explain where Braintree is located. Nor did any witness identify the location of the "Quincy" mentioned in the first page of the Cavanagh memorandum to Moore (Exhibit G), which states that "Figures 2 and 3 show the transmit response measured at Quincy." However, this is not the only evidence of record which tends to show where the acts occurred. All of

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the witnesses except Cavanagh¹⁹ identified their residences at the time of their testimony (June 1991) as various cities in Massachusetts (namely, Norwood, Rockland, Easton, Stoughton, and Duxbury) and explained that they worked for Hazeltine, Cavanagh's assignee, in August 1988 (the time of the alleged actual reduction to practice). As requested by Cavanagh in his opposition to McMahon's motion to strike, we are taking "official notice"²⁰ of the fact that these cities are all located in the eastern part of the state, as can be ascertained from any detailed road atlas. While the witnesses did not explain where they resided during August 1988, we believe it is reasonable to conclude that they resided in the same area then as they did at the time of their testimony, as it is unlikely that they would have moved in the interim to eastern Massachusetts from another area, let alone an area near or in a foreign country. We are also granting Cavanagh's request to take official notice of the fact that eastern

¹⁹ Cavanagh did not give his place of residence or employment.

²⁰ Cavanagh's request used the term "judicial notice." 37 CFR § 1.671(c)(3) explains that the term "judicial notice" in the Federal Rules of Evidence means "official notice" in the context of an interference proceeding before the Board.

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Massachusetts includes cities named "Braintree" and "Quincy," and agree with Cavanagh that it is reasonable to conclude that these are the cities referred to respectively in Pelrin's testimony and in Cavanagh's memorandum to Moore. As requested, we also are taking official notice of the fact that the border with Canada, the closest foreign country, is about a five hour round trip by car. However, we will not grant Cavanagh's request to take official notice that "Hazeltine Corporation is a famous American Company in the electronics field" (Opp. at 3), which even if granted would not prove it to be more likely than not that the tests Packard observed took place in this country. In our view, Cavanagh's evidence, when considered in light of the foregoing officially noticed geographical facts is sufficient to establish by a preponderance of the evidence (i.e., that it is more likely than not) that the testing observed by Packard occurred in the United States. Indeed, there is no evidence at all to the contrary.

McMahon's objections²¹ to Cavanagh's request for official notice have been considered but are not persuasive.

²¹ Reply for Motion to Strike at 3-4.

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McMahon contends Cavanagh failed to comply with paragraph (b) of Rule 201 of the Federal Rules of Evidence ("Judicial Notice of Adjudicative Facts"), which as applied to interferences by 37 CFR § 1.671(c) requires that the asserted fact

be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the [Board] or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.

In arguing that the geographical facts in question are not "capable of accurate and ready determination by resort to any specified sources" (our emphasis),²² McMahon is apparently relying on paragraph (d) of the rule, which reads: "When mandatory. A court shall take judicial notice if requested by a party and supplied with the necessary information." Assuming for the sake of argument that Cavanagh's failure to submit proof of the geographical facts in question violates this provision, we are taking notice of these sua sponte pursuant to paragraph (c) of the rule, which reads: "(c) When discretionary. A court may take judicial notice, whether requested or not."

²² Reply for Motion to Strike at 3.

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McMahon also complains that the lateness of Cavanagh's request to take official notice deprived him of an opportunity to submit contradictory or rebuttal evidence, citing paragraph (e) of the rule, which reads:

(e) Opportunity to be heard. A party is entitled upon timely request to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken.

This paragraph does not support McMahon's contention that he should be allowed to submit contrary evidence; it simply requires that a party who so requests be given an opportunity to be heard on the propriety of taking judicial notice. See the Advisory Committee Note to paragraph (e), which states that "[w]ithin its narrow area of adjudicative facts, the rule contemplates there is to be no evidence before the jury in disproof." McMahon's opportunity to be heard on this issue, of which he took advantage, was his reply to Cavanagh's opposition to his motion to suppress.

McMahon's second ground for attacking Cavanagh's evidence of an actual reduction to practice is that the count, which recites staves having a "predetermined shape," implicitly requires curved staves in order to be operable and

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that "Exhibits A, B, and D do not clearly show staves which are curved or concave" (Br. at 12). Cavanagh does not dispute that the staves of the count necessarily must be curved to produce an operative device. Instead, he argues (Reply Br. at 6-7) that the curvature of the staves is: (a) described in handwritten notation in Exhibit B; (b) apparent from the photographs of Exhibit D; (c) depicted in Exhibit F and in Figures 1, 2, 5, and 6 of Exhibit G; and (d) discussed in DiCaprio's affidavit [CR 8-9]. It is not necessary to decide whether this evidence supports Cavanagh's position because McMahon's undisputed contention that the count implicitly requires curved staves in order to be operative would appear to be equally applicable to the device shown in Exhibits A, B, and D, which Packard witnessed under test. It is readily apparent from Exhibit A, the sketch of the assembled device, that voltage-induced variations in the longitudinal length of the piezoelectric stack in this device will cause transverse vibration of the staves (resulting in acoustic waves in the surrounding water) only if the staves have some inward or outward curvature when at rest. As a result, Cavanagh has shown by a preponderance of the evidence that the staves used

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in the device he saw being tested in August 1988 were curved, the only limitation McMahon argues was lacking in that device.

In order for the tests observed by Packard to establish an actual reduction to practice, "there must be a relationship between the test conditions and the intended functional setting . . . and the tests must prove that the invention will perform satisfactorily in the intended functional setting." Koval v. Bodenschatz, 463 F.2d 442, 447, 174 USPQ 451, 455 (CCPA 1972). Furthermore, Cavanagh must prove that the operability of the tested device was recognized and appreciated by Cavanagh (or by someone acting on his behalf who was in a position to judge the success of the tests) prior to McMahon's filing date. Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 594, 44 USPQ2d 1610, 1614-15 (Fed. Cir. 1997). Cavanagh's evidence fails satisfy any of the foregoing requirements. No witness (including Cavanagh) disclosed the conditions of the tests witnessed by Packard or explained why those conditions modeled the intended working environment. Nor did any witness explain the data represented in the graph of Exhibit C, as required by 37 CFR § 1.671(f): "The significance of documentary and other exhibits identified

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by a witness in an affidavit or during oral deposition shall be discussed with particularity by a witness." The basis for this rule is discussed in Davis v. Uke, 27 USPQ2d 1180, 1185 (Comm'r Pats. & Trademarks 1993):

[T]he significance of documentary and other exhibits must be discussed with particularity by a witness during oral deposition or in an affidavit. See Notice of Final Rule, 49 Fed. Reg. 48416, 48428 (Dec. 12, 1984), reprinted in 1050 Off. Gaz. Pat. Office 385, 397 (Jan. 29, 1985); Popoff v. Orchin, 144 USPQ 762 (Bd. Pat. Int. 1963) (unexplained experimental data should not be considered); Chandler v. Mock, 150 F.2d 563, 66 USPQ 209 (CCPA 1945) (records standing alone were held to be meaningless); and Smith v. Bousquet, 111 F.2d 157, 45 USPQ 347 (CCPA 1940) (unexplained tests in stipulated testimony are entitled to little weight). See also In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974) and Triplett v. Steinmayer, 129 F.2d 869, 54 USPQ 409 (CCPA 1942).

However, Moore's testimony about the tests described in the memorandum from Cavanagh (Exhibit G) is offered to show that Exhibit C represent a successful test. Specifically, Moore testified that he has "compared the invention described in the [Cavanagh] patent application to the invention described in that memorandum and found them to be one in [sic, and] the same" (CR 11, para. 4) and that

[b]ased on the design information and the corresponding testing presented in the September 16th memorandum, it is my expert opinion as former Director of Engineering, that the above referenced

invention was sufficiently tested at that time to demonstrate that the device worked for its intended purpose. The opinion is based on the transmit response data obtained from the prototype design shown in that memo. In fact, the highly favorable performance data obtained from that test as reported in the attached memorandum resulted in the decision to continue working on this particular design. Subsequent tests of Mr. Cavanagh's design repeated the excellent performance presented in the September 16th memorandum. This design is now considered to be an important part of the firm's product line.
Ibid.

The contention that this testimony demonstrates the success of the test results shown in Exhibit C is unpersuasive for two reasons. The first is that neither Moore nor any other witness explained the test data in either exhibit or explained why the test data in these two exhibits are comparable. Second, Moore failed to explain why the test data in Exhibit G persuade him that the tests described therein were successful.

Even assuming for the sake of argument that the test results in Exhibit C are sufficient to establish successful operation of the device Packard saw tested, Cavanagh's evidence is still deficient for failing to demonstrate that the success of those tests was recognized and appreciated prior to McMahon's November 15, 1988, filing date. Estee Lauder, 129 F.3d at 594, 44 USPQ2d at 1614-15. While Packard

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testified that he confirmed the success of the August 1988 tests by signing Exhibits E and F, he did not confirm the accuracy of the September 26, 1988, date that follows his signatures on those exhibits. It is well settled that dates on exhibits cannot be accepted as true without being explained in an affidavit or testimony. See Cislak v. Wagner, 215 F.2d 275, 278, 103 USPQ 39, 41 (CCPA 1954) ("It [is] an essential requirement that evidence be offered to show that an exhibit . . . was, in fact, made on the date appearing thereon."); Sloan v. Peterson, 129 F.2d 330, 337, 54 USPQ 96, 103 (CCPA 1942). Compare Price v. Symsek, 988 F.2d 1187, 1196, 26 USPQ2d 1031, 1037-38 (Fed. Cir. 1993) (witness testified that she recalled seeing drawing on or around the date appearing thereon). Nor is there testimony by any other witness (including Cavanagh) explaining when the test results were first considered to be successful.

For the foregoing reasons, we conclude that Cavanagh has failed to prove an actual reduction to practice prior to McMahon's November 15, 1988, filing date, by a preponderance of the evidence. As this is an essential element of Cavanagh's priority case, we need not address Cavanagh's

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evidence of conception or diligence. Priority as to the subject matter of the count therefore is being awarded infra to McMahon, with the result that judgment is being entered against all of Cavanagh's involved claims. Consequently, it is not necessary to consider (a) McMahon's contention that Jones's disclosures at Miami meeting constituted an actual reduction to practice, (b) McMahon's contention that Cavanagh's claims are unpatentable under 35 U.S.C. §§ 102(a) and/or 103 over those disclosures, or (c) Cavanagh's motion to suppress much of the evidence that McMahon relies on to establish what was disclosed at the Miami meeting. Nonetheless, in the interest of completeness we have considered these issues.

Cavanagh's motions to suppress

McMahon's record consists of the first Jones affidavit (which accompanied McMahon's initial § 1.633(a) motion), Jones's deposition testimony, the Lindberg affidavit that accompanied McMahon's belated § 1.633(a) motion, the Schmid affidavit that was submitted with McMahon's first request for reconsideration of the June 2, 1994, decision on final hearing, and new affidavits by Jones, Chapman, and

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Ellis, which were submitted during McMahon's testimony-in-chief period.

Cavanagh filed two motions to suppress all of the foregoing testimony with the exception of the testimony that was considered in the June 2, 1994, decision on final hearing, i.e., the first Jones affidavit and the Jones deposition testimony. According to Cavanagh, the remaining testimony is entitled to no consideration because it was not submitted in compliance with the APJ's order of February 28, 1995, which specifies that "a party may take or present new direct testimony with respect to [a denied preliminary motion] by seeking leave to do in a motion under § 1.635 [footnote omitted], which must satisfactorily explain why the testimony was unavailable when the corresponding preliminary motion . . . was filed."²³ Cavanagh notes that McMahon failed to file such a motion or provide a satisfactory explanation of why the testimony in question was unavailable when the first § 1.633(a) motion was filed. McMahon correctly counters that he is entitled to rely on these affidavits as evidence of priority, i.e., to support his contention that the disclosures

²³ Paper No. 85, at 9.

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at the Miami meeting constituted an actual reduction to practice. For this reason, the motion to suppress these affidavits is denied. The question of how much of this evidence is entitled to consideration in connection with the patentability issue is addressed infra in the discussion of that issue.

McMahon's case for an actual reduction to practice

McMahon concedes that Jones's disclosure, at the November 1987 Miami meeting, of the structure of a device made in Canada constitutes evidence of conception only, citing DeKando v. Armstrong, 169 Off. Gaz. Pat. & Trademark Office 1185, 1911 Comm'r Dec. 413 (App. D.C. 1911). According to McMahon, Jones's additional detailed disclosure at that meeting of tests performed in Canada constitutes an actual reduction to practice in this country. No authority is cited in support of this proposition and we are aware of none. Testing performed abroad to prove that an invention works for its intended purpose clearly constitute a foreign activity relied on to establish a date of invention and thus is excluded by 35 U.S.C. § 104 from the evidence that can be relied on to establish a date of invention in this country.

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See Shurie v. Richmond, 699 F.2d 1156, 1158, 216 USPQ 1042, 1044 (Fed. Cir. 1983)("An actual reduction to practice in Canada is irrelevant in an interference proceeding concerning priority of invention") (quoting Wilson v. Sherts, 81 F.2d 755, 760, 28 USPQ 381, 383-84 (CCPA 1936))²⁴; Colbert v. Lofdahl, 21 USPQ2d 1068,

1071 (Bd. Pat. App. & Int. 1991):

If the invention is reduced to practice in a foreign country and knowledge of the invention was brought into this country and disclosed to others, the inventor can derive no benefit from the work done abroad and such knowledge is merely evidence of conception of the invention. DeKando v. Armstrong, 169 O.G. 1185, 1911 CD 413 (App. D.C. 1911); see also 35 U.S.C. 104. [Footnote omitted.] However, the nature of the work abroad might be important in determining the identity of the invention or whether the inventor had any concept of it or not, but it is incumbent upon the inventor to prove that the invention was introduced into the United States. Breuer v. DeMarinis, 558 F.2d 22, 194 USPQ 308 (CCPA

²⁴ McMahon also cites Shurie v. Richmond, 699 F.2d at 1158, 216 USPQ at 1044, for the proposition that "importation of a product into the United States does constitute reduction to practice of the process of making that product in the United States" (Br. at 22). Actually, Shurie held just the opposite: "[T]he count concerns only a process-which was never performed by Shurie in the United States. We agree with the Board that a product produced by a particular process is not equivalent, for patent entitlement purposes, to the performance of the process in the United States." 699 F.2d at 1159, 216 USPQ at 1045.

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1977); and Rebuffat v. Crawford, 68 F.2d 980, 982, 20 USPQ 321, 324 (CCPA 1934). Introduction of the invention into this country on behalf of the inventors must be judged by what knowledge was imparted to others and by the items brought into the U.S. by Lofdahl. Micheletti v. Tapia, 196 USPQ 858 (Bd. Pat. Int. 1976).

The alleged unpatentability of Cavanagh's claims over disclosures made at the Miami meeting

To prove that Cavanagh's involved claims are unpatentable over disclosures made by Jones at the Miami meeting, McMahon relies alternatively on the following evidence:

(a) the first Jones affidavit and the Jones deposition testimony, which is the evidence previously considered in the June 2, 1994, decision on final hearing;

(b) the foregoing evidence plus the Lindberg affidavit, which was submitted with McMahon's denied belated § 1.633(a) motion; and

(c) all of the foregoing evidence plus the Schmid affidavit (initially filed with McMahon's first request for reconsideration of the June 2, 1994, decision on final hearing and refused consideration on the ground that it is improper to submit new evidence with such a request) and the new

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affidavits by Jones, Chapman, and Ellis that were submitted during McMahon's testimony-in-chief period.

McMahon's argument that Cavanagh's claims are unpatentable over the first Jones affidavit and the Jones deposition testimony, i.e., the evidence considered in the June 2, 1994, decision on final hearing, is not entitled to consideration at this final hearing, because the earlier decision is the law of the case on that question. See Interference Practice: Response to Order to Show Cause Under 37 CFR 1.640, 1074 Off. Gaz. Pat. & Trademark Office 4 n.* (Jan. 6, 1987):

It should be recognized that the decision of the Board following the final hearing may not terminate the interference. For example, if the order to show cause resulted from an Examiner-in-Chief's grant of a motion for judgment, and the Board after final hearing reversed the Examiner-in-Chief's decision, the case might then proceed to the taking of priority testimony. The Board's decision would however be final with regard to the basis of the motion for judgment. [Emphasis added.]

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As for the Lindberg affidavit, McMahon argues that APJ abused his discretion²⁵ by denying the belated § 1.633(a) motion and refusing to consider the Lindberg affidavit on the ground that the accompanying affidavit by McMahon's counsel, Mark Bicks, failed to show good cause for the delay.²⁶

Although McMahon's brief (at 40-41) purports to summarize Bicks's testimony, his affidavit is not included in McMahon's (or Cavanagh's) record. As a result, the explanation offered in the brief for the delay is unsupported by any evidence of record and thus constitutes mere attorney argument, which is not entitled to any weight. Meitzner, 549 F.2d at 782, 193 USPQ at 22. Furthermore, even if the Bicks affidavit were of

²⁵ This is the standard of review for an interlocutory decision by an APJ. 37 CFR § 1.655(a). An abuse of discretion may be found when (1) the decision of an APJ is clearly unreasonable, arbitrary or fanciful, (2) the decision is based on an erroneous conclusion of law, (3) the findings of the APJ are clearly erroneous, or (4) the record contains no evidence upon which the APJ rationally could have based the decision. 1995 Final Rule Notice, 60 Fed. Reg. at 14514-15, 1173 Off. Gaz. Pat. & Trademark Office at 58 (citing Heat and Control, Inc. v. Hester Industries, Inc., 785 F.2d 1017, 1022, 228 USPQ 926, 930 (Fed. Cir. 1986); Western Electric Co. v. Piezo Technology, Inc. v. Quigg, 860 F.2d 428, 430-31, 8 USPQ2d 1853, 1855 (Fed. Cir. 1988); and Abrutyn v. Giovanniello, 15 F.3d 1048, 1050-51, 29 USPQ2d 1615, 1617 (Fed. Cir. 1994)).

²⁶ Paper No. 80.

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record, McMahon's argument that it shows good cause for the belatedness of the Lindberg affidavit fails because McMahon has not persuaded us the APJ's reasoning to the contrary is incorrect. Specifically, the APJ held that if, as Bicks testified, Lindberg was identified as a potential witness on November 19, 1992, one week before the November 26, 1992, due date for preliminary motions, McMahon should have requested an extension of time for filing preliminary motions pursuant to § 1.645(a) or included in his initial § 1.633(a) motion a § 1.639(c) request to take Lindberg's testimony in support thereof. McMahon contends that neither of these courses of action was appropriate because when the preliminary motions were due, McMahon did not know "the specific acts the witness, Mr. Lindberg, would definitely testify to and when and if such testimony could be obtained" and that insufficient time existed to obtain a decision on a motion for an extension of time (Br. at 40).

Assuming for the sake of argument that McMahon is correct in this regard, we agree with the APJ's conclusion that McMahon has not satisfactorily explained the three-year delay in obtaining and filing the Lindberg affidavit

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(initially filed on December 22, 1994, with the second request for reconsideration of the June 2, 1994, decision on final hearing). The Bicks affidavit described the efforts required to obtain permission for Lindberg to testify from the Office of General Counsel of the U.S. Navy, Lindberg's employer.

These efforts were described by the APJ as follows:²⁷

Following Bicks's November 25, 1991, telephone conversation with Lall [of the General Counsel's office], during which Lall promised to send Bicks further information when it became available, McMahon waited four and one-half months, until May 12, 1992, to send Lall a follow-up letter noting the lack of any response and making a "formal" written request for Lindberg's testimony (Ex. A). (It was during this four and one-half month period that the undersigned issued papers 15 and 22 deferring consideration of the first motion to final hearing.) While McMahon was certainly entitled to wait awhile for an answer, four and one-half months is too long to be considered reasonable diligence on McMahon's part. However, this period of inactivity pales in comparison to a later period of inactivity lasting twenty-two months. On May 15, 1991, Lall telephoned Bicks to request further details, which Bicks provided in a letter faxed and mailed to Lall on May 18, 1992 (Ex. B). Three months later, on August 18, 1992, McGowan sent Bicks a letter (Ex. C) indicating that his request was not in compliance with the Navy regulations (copy enclosed) governing requests to take testimony of Navy personnel. Between McMahon's May 18, 1992, letter and McGowan's August 18, 1992, response, the undersigned considered and granted the initial motion, concluding that the Jones affidavit

²⁷ Paper No. 80, at 7-8.

and exhibits filed with the motion are sufficient to establish a prima facie case for unpatentability. McMahon thereafter ceased its efforts to obtain the Lindberg testimony until just after the board's June 2, 1994, decision holding Jones'[s] uncorroborated testimony insufficient to establish a prima facie case for unpatentability. Specifically, the renewed effort began on June 20, 1994, when Bicks sent McGowan a letter renewing the request for testimony (Ex. D), including the additional information required by the regulations and accompanied by a draft affidavit for Lindberg's signature.

McMahon argues that the twenty-two month period of inactivity is excusable because after the APJ's June 30, 1992, decision granting the initial § 1.633(a) motion,

the Lindberg testimony was no longer necessary such that continued efforts to obtain that testimony could not be justified. Only after the [June 2, 1994] decision on final hearing was rendered and the need for the Lindberg testimony was re-established, could McMahon et al. justify further efforts to obtain the Lindberg testimony. [Br. at 41.]

We do not agree that the APJ's favorable decision on the initial motion temporarily relieved McMahon of the duty to promptly obtain and file the affidavit. A party has a duty to present promptly all of the available evidence on which he intends to rely in support of a motion. See Irikura v.

Petersen, 18 USPQ2d 1362, 1368 (Bd. Pat. App. & Int. 1990):

A good faith effort must be made to submit evidence to support a preliminary motion or opposition when the evidence is available. Orikasa v. Oonishi, [10

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USPQ2d 1996, 2000 n.12 (Comm'r Pats. and Trademarks 1989)]. Note the commentary [Patent Interference Proceedings; Final Rule (1984)] 49 F.R. 48424, at 48442, . . . 1050 O.G. 393 at 411 indicating that if affidavits cannot be timely prepared and filed with a motion, the moving party may wish to take advantage of Rule 1.639(c) which requires a party to specify any testimony needed to resolve the motion. Irikura et al. did not avail themselves of this rule nor the [extension of time] provisions of §1.645.

Evidence is considered to have been available if it was on hand or could have been discovered with reasonable effort.

See Maier v. Hanawa, 26 USPQ2d 1606, 1610 (Comm'r Pats. & Trademarks 1992):

[I]t is incumbent on a party to make its best reasonable effort within the time period allotted by the EIC [APJ²⁸] to uncover all evidence on which it would rely in making a preliminary motion. If information which could have been discovered with reasonable effort within the period set by the EIC, its later discovery after expiration of the period would not be sufficient cause for delay in the late filing of any preliminary motion relying on that information [footnote regarding extensions of time under § 1.645 omitted].

The duty to use reasonable efforts to obtain all relevant evidence on which the party intends to rely in support of a

²⁸ Effective October 15, 1993, Examiners-in-Chief (EICs) have been authorized to use the title Administrative Patent Judge. See New Title for Examiners-in-Chief, 1556 Off. Gaz. Pat. & Trademark Office 32 (Nov. 9, 1993).

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motion begins with the filing of the motion, not its denial. See Hanagan v. Kimura, 16 USPQ 1791, 1794 (Comm'r Pats. & Trademarks 1990) ("It is not appropriate to file a motion, see if the motion will be granted, and then ask for testimony if the motion is denied."). The duty to promptly obtain and file relevant evidence also exists with respect to belatedly filed motions, I.,e., motions filed after the close of the preliminary motion period. See Interference Practice: Matters Relating to Belated Preliminary Motions, 1144 Off. Gaz. Pat. Office 8 (Nov. 3, 1992) (where evidence that provides a basis for a § 1.633(a) motion does not come to light until after the end of the preliminary motion period, the board will not consider the matter unless the party, promptly after the evidence becomes available, files a belated § 1.633(a) motion accompanied by a § 1.635 motion showing good or sufficient cause for the belatedness). For the foregoing reasons, the twenty-two month hiatus in McMahon's efforts to obtain Lindberg's affidavit cannot be excused on the ground that the initial motion, based only on the first Jones affidavit, was granted by the APJ. Nor can this period of inactivity be excused on the ground that

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McMahon did not recognize the need for the affidavit until the APJ's decision granting the motion was reversed in the June 2, 1994, decision on final hearing. Compare Hahn v. Wong, 892 F.2d 1028, 1035, 13 USPQ2d 1313, 1319 (Fed. Cir. 1989) (Hahn's counsel's alleged failure to appreciate the need for corroborating evidence as part of Hahn's § 1.608(b) showing does not constitute good cause under § 1.617(b) for waiting until after receiving a § 1.617(a) order to show cause to submit such evidence). It is well settled that a change of opinion or purpose on the part of the moving party or his attorney does not constitute good cause for filing a late motion. Suh v. Hoefle, 23 USPQ2d 1321, 1324 (Bd. Pat. App. & Int. 1991) (citing II C. Rivise & A. Caesar, Interference Law and Practice § 270 (Michie Co. 1947)). As a result, the APJ did not abuse his discretion by denying McMahon's belated motion on the ground that McMahon failed to show good cause for the delay in obtaining and filing the Lindberg affidavit.

McMahon also argues that all of the testimony in his record should be considered because "[t]he Board has a duty to consider all evidence relevant to the patentability issue of the Cavanagh application claims before it can satisfy the

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public policy against knowingly issuing invalid patents" (Br. at 42).

McMahon further contends that "[i]f Cavanagh does not have all of the evidence considered in the McMahon et al. Record considered in determining the patentability of its pending application claims, it can cause a violation of its duty of disclosure in connection with its pending patent application" (id.).

These arguments are unconvincing for a number of reasons. The first reason is that they overlook McMahon's duty to timely file the evidence, discussed infra, which is a condition for having the evidence considered during an interference. The second reason, which Cavanagh raised in his motion to suppress, is McMahon's failure to file a § 1.635 motion requesting permission to rely on the new affidavits by Jones, Chapman, and Ellis in support of his initial § 1.633(a) motion or his belated § 1.633(a) motion, as required by the APJ in paper No. 85 (at 9). The fact that McMahon additionally relies on these affidavits as evidence of priority does not

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excuse his failure to comply with this requirement.²⁹ Third, the suggestion that the public interest in preventing the issuance of invalid patents can only be served by having all of McMahon's evidence that relates to unpatentability considered in this interference is incorrect. In the event Cavanagh is able to obtain judgment on priority in his favor in an appeal (35 U.S.C. § 145) or a civil action (§ 146), thereby avoiding judgment against his claims on that ground, the patentability issue can be addressed by the examiner in ex parte proceedings following termination of this interference. Moreover, at that time Cavanagh can comply with his duty of disclosure by calling the examiner's attention to the affidavit and deposition testimony filed by McMahon in this interference.

For all of the foregoing reasons, even if judgment were not being entered against Cavanagh's involved claims on the ground of priority, we would not enter judgment against those claims on the ground of unpatentability over the disclosures made by Jones at the Miami meeting.

²⁹ Had Cavanagh known that McMahon intended to rely on the new affidavits with respect to the patentability issue, he might have elected to cross-examine these witnesses.

Judgment

Judgment on the issue of priority with respect to the subject matter of the count is hereby awarded in favor of McMahon and Jones, who are therefore entitled to their involved patent claims that correspond to the count, i.e., claims 1-20. Accordingly, judgment on the issue of priority is hereby entered against Cavanagh, with the result that he is not entitled to a patent including his application claims that correspond to the count, i.e., claims 1-28.

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